

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Formalities

The objection to the specification, set forth on page 7 of the Official Action, has been addressed by amending page 7 of the specification to refer to Figs. 17 and 18.

The objections to Fig. 19 for failing to show the conductive buttons 21 on the controller, and for improperly including reference numeral “31,” has been addressed by changing reference numeral “31” to –21– (the buttons being on the back side of the controller), and by adding an explanation that the buttons are better shown in Fig. 4).

2. Rejection of Claims 1-10, 12, and 14 Under 35 USC §101

This rejection has been addressed by amending claims 1 and 2 to recite that the plates are –adapted to be– in direct contact with the human body, as suggested by the Examiner, rather than in direct contact as originally claimed.

3. Rejection of Claims 1-10, 12, and 14 Under 35 USC §112, 2nd Paragraph

This rejection has been addressed by:

- a. amending each of the claims to delete the recitation of “medium and low frequency” massaging effects;
- b. amending claims 2, 8, and 9 to more positively recite the outer and inner (cloth) layers;
- c. amending claim 5 to depend from claim 3, and by amending claim 3 to positively recite pulsed voltages;
- d. amending claims 6 and 7 to delete the “is installed” phraseology;
- e. amending claim 10 by changing “second end” to –first end–; and

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- f. canceling claim 13 (the embodiment of claim 11 does not include conductive strips).

Having thus overcome each of the grounds for rejection under 35 USC §112, 2nd Paragraph, withdrawal of the rejection is respectfully requested.

4. Rejections of Claims 1-10, 12, and 14 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,151,528 (Maida), 5,050,595 (Krafft), 4,148,321 (Wyss), and 6,210,771 (Post)

These rejections are respectfully traversed on the grounds that none of the references cited by the Examiner in item 1 on page 4 of the of the Official Action discloses or suggests a bra with conductive plates and strips, as claimed, for massaging a human chest. Furthermore, the references do not disclose any sort of massaging garment with clustered buttons, as claimed. The only reference that discloses any sort of bra is the Krafft patent, but the Krafft patent merely discloses the inclusion, in the bra, of thermal gel packs. There is no suggestion in the Krafft patent of including conductive plates for massaging the chest.

It is true that the Maida patent discloses a garment with conductive massaging plates. However, the garment of Maida is not a bra. There is no suggestion in the Maida patent of adapting the conductive plates to fit within a bra. Furthermore, the Maida patent does not disclose conductive strips for connecting the conductive plates with a controller via conductive buttons that are clustered at a predetermined location of the a garment. Instead, the conductive buttons (terminals 17,18,19) of Maida are distributed around the garment and **not clustered**. Such an arrangement might be suitable for pants, but is hardly suitable for a bra where the “cup” sections are required to be smooth and not interrupted by buttons.

The Wyss patent does not make up for the deficiencies of the Krafft and Maida patents since the Wyss patent does not teach any sort of garment, much less a bra of the type claimed with conductive plates, strips, and clustered buttons. The Post patent, on the other hand, at least discloses textiles, although there is no suggestion of including the textiles in a bra, and including conductive strips and clustered buttons, as claimed.

Since none of the references suggests incorporating massaging plates in a bra, much less the claimed arrangement of conductive plates, strips, and clustered buttons, it is respectfully submitted that the combination proposed by the Examiner could only have been made in hindsight. The Examiner is reminded that, as explained in *In re Fritch*, 23 USPQ2d 1780,1783 (Fed. Cir. 1992):

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so [quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929,933 (Fed. Cir. 1984)].' Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

It is true that the massager disclosed in the Maida patent *could* have been adapted for a bra, by including conductive plates, strips, and clustered buttons, but there is no suggestion in the Maida patent to do so, and Krafft's suggestion of heat pads (which are used to soften the breast following birth of a baby) is not a suggestion of including conductive plates for massaging purposes.

Instead, it seems that the rejection is based more on the simplicity of the invention than on any suggestions in the references themselves. In particular, it seems that the Examiner has combined the references by selecting isolated teaches based on Applicant's claims, and not by considering how the ordinary artisan would have viewed the teachings of the references as a whole. Such an approach is clearly improper, as explained for example, in *In re Gorman*, 18 USPQ 2d 1886, 1888 (Fed. Cir. 1990), which points out that:

...simply to engage in a hindsight reconstruction of the claim invention, using the applicant's structure as a template and selecting elements from references to fill the gaps [citing Interconnect Planning Corporation v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985)].

Thus, while the Examiner might be able to base a rejection on knowledge that he knows would have been available to those of ordinary skill in the art at the time the invention was made, and that are not explicitly in the references, it is necessary to ensure that the knowledge is knowledge which in fact would have caused the ordinary artisan to make the modification, and that the Examiner has not, upon viewing the invention, decided that the invention is so simple that one of ordinary skill in the art must have been able to carry it out. The latter approach is not a proper approach because most inventions, which would not have been obvious at the time they were made, could be argued to be obvious in hindsight. The best approach would be to understand the invention and then to make sure that the modification of the prior art is in fact suggested by the references **as a whole**, which is not the case here. According to the above cases, if no reason was apparent at the time the invention was made to modify the reference, then the ordinary artisan would not have modified it.

Because the four references cited by the Examiner do not suggest including massaging elements of the type disclosed by Maida in a bra of the type disclosed by Krafft, withdrawal of the rejection under 35 USC §103(a) is respectfully requested.

5. Rejection of Claims 11 and 13 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,453,203 (Yamazaki) and 5,690,537 (Kalmus)

This rejection is respectfully traversed for the same reason as the above rejection, namely on the grounds that none of the references cited by the Examiner discloses or suggests a bra with conductive plates and strips, as claimed, for massaging a human chest. The only reference applied against claims 11 and 13 that discloses any sort of bra is the Kalmus patent, but the Kalmus patent merely discloses the inclusion, in the bra, of inserts that protect against radiation. The inserts of Kalmus are conductive, but do not contact the chest, and do not provide any massaging effect. On the other hand, the Yamazaki patent is directed to electrode tights that do not include a bra. There is no suggestion in the Yamazaki patent of providing conductive plates that can be inserted into a bra for massage purposes. As a result, it is respectfully submitted that

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the rejection could only have been made in hindsight, and withdrawal of the rejection is respectfully requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to be 'B. Urcia', with a long horizontal flourish extending to the right.

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AMENDMENTS TO DRAWINGS

Please amend Fig. 19 by changing reference numeral "31" to -21-, as indicated in the attached REPLACEMENT SHEET.